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10/748,889	12/30/2003	Jay Z. Muchin	039014-0101	7443

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EXAMINER
REYNOLDS, STEVEN ALAN

ART UNIT	PAPER NUMBER
3728	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,889

Applicant(s)

MUCHIN ET AL.

Examiner

Steven Reynolds

Art Unit

3728

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,16,17,19,87,88,90-100,105,108-111,113,114 and 124-171 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,16,17,19,87,88,90-100,105,108-111,113,114 and 124-171 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/2008 has been entered.

Claim Objections

2. Claims 113, 126 and 159 are objected to because of the following informalities:
Claim 113 should depend from claim 1, not canceled claim 112.
Claim 126 should depend from claim 125 to correct antecedent basis problems.
In claim 159, line 2, "capture" should be "aperture".
Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 154 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The graphics claimed in claim 154 cannot have distinct surface textures if in claim 124 the batteries are identical.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7, 9-11, 16, 17, 19, 87, 88, 90-100, 105, 108-111, 113, 114, 124-130, 132-153 and 155-169 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalton (US 6,238,818). Regarding claims 1, 10, 97, 113, 124, 133, 150, 159 and 160, Dalton discloses a battery bundle (package is used in a flashlight); a first battery having an outer surface with a first graphic; a second battery having an outer surface with a second graphic distinct from the first graphic; and a packaging (4) binding the first battery and the second battery, wherein the packaging has a first aperture (aperture 70 in cavity 62) adjacent to the first battery and a second aperture (aperture 70 in cavity

64) adjacent the second battery wherein the first aperture and the second aperture are configured to facilitate rotation of the first battery and the second battery by rotating the circumferential sides, respectively, while within the packaging.

Dalton discloses the claimed invention except for the first graphic being distinct from the second graphic and the first and second battery having a distinct outer surface texture. It is well known and would have been obvious to use different brands of batteries together in the cartridge if that is all the consumer has to use in combination. Therefore, the graphics on the different brands of batteries will be distinct from each other and inherently have graphics in two different locations.

Regarding claims 2, 3, 125, 126 and 164, Dalton discloses the claimed invention except for the specific material of the packaging. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the packaging from any material such as a transparent material in order to allow the entire outer surface of the batteries to be viewed while they are in the packaging. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 4-7, 9, 127-130, 132, 165 and 166, Dalton discloses the first battery and the second battery are substantially aligned end-to-end in the packaging; the battery bundle includes batteries in addition to the first battery and the second battery and wherein all of the batteries bound by the packaging are aligned end-to-end in the packaging; and a single tube containing all of the batteries.

Regarding claims 11, 16, 17, 87, 134-136 and 140, it is well known and would have been obvious to use different brands of batteries together in the cartridge if that is all the consumer has to use in combination; the consumer may also have two batteries being the same brand in combination with one battery of a different brand in the same cartridge. It is also well known by one of ordinary skill in the art that all batteries have an outer surface texture. The package can be considered a membrane or film as it is made from plastic and is inherently flexible.

Regarding claims 19, 93-96, 99, 105, 110, 137, 138, 146-149, 152, 157, 162 and 167-170, although Dalton is silent about the contents of the graphics on the batteries, it is well known in the art for the graphics on a battery to include the following: the brand name logo (which is artwork and an object) or any single word, graphics targeting the group of consumers who intend to purchase the brand of batteries and graphics extending 360 degrees about the outer surface of the battery.

Regarding claims 91, 92, 98, 144, 145 and 151, Dalton as described above is capable of holding two batteries of the same brand with distinct logos, as one battery can be rechargeable and the second battery could be a regular battery. These batteries would have distinct graphics, as the rechargeable battery would include the graphic "rechargeable".

Regarding claims 100 and 153, associated with the graphics, the genus is a certain brand of battery and the two species of that genus are rechargeable and non-rechargeable.

Further, with respect to the graphics and the subjects of the graphics, they are printed matter that are absent of any new and unobvious functional relationship with respect to the substrate (battery). Accordingly, such printed matter has no patentable weight. See *in re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

Regarding claims 108, 109 and 154-156, the batteries would have a distinct surface texture as it is well known that the outer label of batteries have been made from paper, which would have a different surface texture than the batteries made from plastic film or metal, the scents of these materials would be different as well. Further, the scent of the paper type battery can be selectively activated by scratching.

Regarding claims 111 and 158, Dalton discloses the first battery and the second battery have longitudinal axes non-coincident and parallel to one another (as there is space between the side wall of the packaging and the batteries, there is room for the batteries to shift to the side causing the batteries to be non-coincident and parallel with one another).

Regarding claim 168, the related theme is the alphabet, and each of the two graphics have certain letters from the alphabet present.

Regarding claims 88, 90, 139, 141-143 and 163, Dalton discloses the packaging is capable of binding batteries for retail distribution with the device; a support portion (end wall of the flashlight) including a hang hole (it is well known in the art for flashlights to have hand straps connected to the end wall - As shown in Watterson US 2002/0149928); and the support portion including a pedestal (end wall of the flashlight).

Regarding claims 114 and 161, Dalton discloses the first battery extends along an axis and wherein the packaging includes a wall (package end wall) extending across and intercepting the axis.

8. Claim 171 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hammel (US 4,123,598). Hammel discloses a battery bundle comprising a first and second battery having graphics; batteries in addition to the first and second batteries; a package comprising a plurality of tubes (See Fig. 4 embodiment) binding the batteries in an end-to-end relationship.

Hammel discloses the claimed invention except for the first graphic being distinct from the second graphic and the first and second battery having a distinct outer surface texture. It is well known and would have been obvious to use different brands of batteries together in the cartridge for an appliance if that is all the consumer has to use in combination.

Regarding the transparent material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the packaging from any material such as a transparent material in order to allow the entire outer surface of the batteries to be viewed while they are in the packaging. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claims 1-11, 16, 17, 19, 87, 88, 90-100, 105, 108-111, 113, 114, 124-141, 143-153 and 155-170 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammel (US 4,123,598) in view of Dalton (US 6,238,818). Regarding claims 1, 10, 97, 113, 124, 133, 150, 159 and 160, Hammel discloses a battery bundle comprising a first and second battery having graphics; a packaging binding the first and second battery (See Fig. 4 embodiment).

Hammel discloses the claimed invention except for the first graphic being distinct from the second graphic and the first and second battery having a distinct outer surface texture. It is well known and would have been obvious to use different brands of batteries together in the cartridge for an appliance if that is all the consumer has to use in combination. Therefore, the graphics on the different brands of batteries will be distinct from each other and inherently have graphics in two different locations.

Dalton discloses the claimed invention except for the specifics of the packaging. Dalton teaches a battery packaging (4) for use in an appliance comprising a first aperture (aperture 70 in cavity 62) and a second aperture (aperture 70 in cavity 64) adjacent a first and second battery when placed in the packaging, wherein the first and second apertures are capable of facilitating rotation of the batteries within the package for the purpose of easily determine which direction is correct for the proper installation of a battery, even if low light is present (See Column 4, lines 61-67). Therefore, it would have been obvious to one of ordinary skill in the art to have modified the packaging of Hammel with apertures adjacent each battery as taught by Dalton in order to more easily insert batteries in the package in the correct direction. The device of Hammel as

modified by Dalton will result in the circumferential sides of the batteries to be exposed through the packaging to facilitate rotation of the batteries while in the packaging.

Regarding claims 2, 3, 125, 126 and 164, Hammel-Dalton discloses the claimed invention except for the specific material of the packaging. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the packaging from any material such as a transparent material in order to allow the entire outer surface of the batteries to be viewed while they are in the packaging. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 4-9, 127-132, 165 and 166, Hammel-Dalton discloses the first battery and the second battery are substantially aligned end-to-end in the packaging; the battery bundle includes batteries in addition to the first battery and the second battery and wherein all of the batteries bound by the packaging are aligned end-to-end in the packaging; the package includes a plurality of tubes (70a, 70b, 70c); and a single tube containing all of the batteries (package can be considered a single tube as it is one enclosed container).

Regarding claims 11, 16, 17, 87, 134-136 and 140, it is well known and would have been obvious to use different brands of batteries together in the cartridge if that is all the consumer has to use in combination; the consumer may also have two batteries being the same brand in combination with one battery of a different brand in the same cartridge. It is also well known by one of ordinary skill in the art that all batteries have an

outer surface texture. The package can be considered a membrane or film as it is made from plastic and is inherently flexible.

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Regarding claims 91, 92, 98, 144, 145 and 151, Hammel-Dalton as described above is capable of holding two batteries of the same brand with distinct logos, as one battery can be rechargeable and the second battery could be a regular battery. These batteries would have distinct graphics, as the rechargeable battery would include the graphic "rechargeable".

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Further, with respect to the graphics and the subjects of the graphics, they are printed matter that are absent of any new and unobvious functional relationship with respect to the substrate (battery). Accordingly, such printed matter has no patentable weight. See *in re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

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Regarding claims 114 and 161, Hammel-Dalton discloses the first battery extends along an axis and wherein the packaging includes a wall (end wall) extending across and intercepting the axis.

Response to Arguments

10. Applicant's arguments with respect to claims 1-7, 9-19, 86-111 and 14-123 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

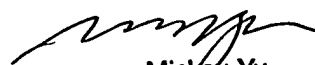
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571) 272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SR

1/24/08



Mickey Yu
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